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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,706	07/13/2001	Masamichi Ito	35.C12551 DI	1058
5514 7590 05/24/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER NEURAUTER, GEORGE C	
			ART UNIT 2143	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/903,706	Applicant(s) ITO ET AL.	
	Examiner George C. Neurauter, Jr.	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/22/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 30-37 are currently presented and have been examined.

Response to Arguments

Applicant's arguments with respect to claims 30-37 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 22 March 2007 was filed after the mailing date of the non-final rejection on 22 September 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

35 USC 112, 6th paragraph Interpretation

The Examiner notes that claims 34-37 recite limitations that are presumed to invoke 35 USC 112, 6th paragraph. If the Applicant wishes such interpretation to be given to the claims, the Applicant must show for the record why the claim language properly invokes 35 USC 112, 6th paragraph and identify the

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function and corresponding structure. The Applicant must also amend the claims, if necessary, to meet the requirements of the 3-prong analysis as prescribed in MPEP 2181. The Examiner also suggests that the Applicant amend the specification, if necessary, to explicitly state what structure corresponds to the recited function with reference to the claimed terms and phrases, provided no new matter is introduced. See 37 CFR 1.75(d) and MPEP 2181.

Claim Interpretation

Claims 30-37 recite the conjunction "if" when reciting steps in conjunction with a conditional step. In view of the broadest reasonable interpretation of the claims as required by MPEP 2111, these limitations may be interpreted in the sense that the limitations occur when the condition step occurs, but also introduces the possibility that the conditional step may not occur, thereby rendering the limitation to be not positively recited. Since the claim fails to recite any specific limitations regarding the possibility that the conditional step may not occur, the broadest reasonable interpretation of the claim allows for the possibility wherein no functionality is achieved when the conditional step is not achieved. Therefore, the above interpretation has been considered during the examination of the claims. If the Applicant wishes the

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limitations to be positively recited, the claims must be amended to either recite limitation in the case wherein the conditional step does not occur or remove such a case from consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 30 and 34 are rejected under 35 U.S.C. 102(a) as being anticipated by "Olympus Digital Vision D-320L D-220L Digital Camera Instructions" ("Olympus").

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55.

The Examiner submits that an English translation is required for the purpose of determining the applicant's right to rely on the foreign filing date. See MPEP § 201.15.

Regarding claim 30, "Olympus" discloses a method of controlling a data communication apparatus, the method comprising the steps of:

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controlling the data communication apparatus to send image data selected by a user to a printer via a serial bus, the image data selected by the user being sent from the data communication apparatus if a send instruction is entered into the data communication apparatus; (see at least page 128, specifically "By connecting the camera to the P-300U printer with the exclusive camera, pictures can be directly sent from the camera....(3) Select the picture you want to print...")

controlling the data communication apparatus to start inhibiting, invalidating or ignoring a predetermined user instruction if the send instruction is entered into the data communication apparatus and controlling the data communication apparatus to stop inhibiting, invalidating, or ignoring the predetermined user instruction if the printer notifies the data communication apparatus that the image data selected by the user is printed. (see at least page 128, specifically "The Condition indicator LED lights while printing, and other operations are disabled")

Claim 34 is also rejected since this claim recites substantially the same limitations as recited in claim 30.

2. Claims 30-32 and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,827,347 to Bell.

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controlling the data communication apparatus to send image data selected by a user to a printer via a serial bus, the image data selected by the user being sent from the data communication apparatus if a send instruction is entered into the data communication apparatus; controlling the data communication apparatus to start inhibiting, invalidating or ignoring a predetermined user instruction if the send instruction is entered into the data communication apparatus; and controlling the data communication apparatus to stop inhibiting, invalidating, or ignoring the predetermined user instruction if the printer notifies the data communication apparatus that the image data selected by the user is printed, also wherein controlling the data communication apparatus to notify a user with a warning message if the predetermined user instruction is entered into the data communication apparatus when the predetermined user instruction is inhibited, invalidated, or ignored, and also wherein the data communication apparatus is an apparatus including at least one video recording unit and at least one camera unit. (column 2, lines 20-34; column 3, lines 30-41) (note that the steps wherein a send instruction is entered into the data communication apparatus, the send instruction is entered into the data communication apparatus, the printer notifies the data communication apparatus that the

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image data selected by the user is printed are conditional, and are interpreted to not occur in accordance with MPEP 2111)

Claims 34-36 are also rejected since these claims recite substantially the same limitations as recited in claims 30-32 respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a),

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the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 31-32 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Olympus" in view of US Patent 6 442 349 B1 to Saegusa et al.

Regarding claim 31, "Olympus" discloses a method according to claim 30.

"Olympus" does not expressly disclose further comprising the step of controlling the data communication apparatus to notify a user with a warning message if the predetermined user instruction is entered into the data communication apparatus when the predetermined user instruction is inhibited, invalidated, or ignored, however, Saegusa does disclose this limitation in the context of providing instructions to a user on a data communication apparatus (see at least column 1, lines 49 and 52-56).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Saegusa discloses that notifying a user with a warning message prevents the user from entering commands when such an operation would be undesirable (see column 1, lines 52-56). In view of these specific advantages and that the references are directed to providing instructions to a user on a data communication apparatus, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Claim 35 is also rejected since this claim recites substantially the same limitations as recited in claim 31.

Regarding claim 32, "Olympus" and Saegusa disclose the method according to claim 30.

"Olympus" discloses wherein the data communication apparatus is an apparatus including at least one video recording unit and at least one camera unit. (see references within "Olympus" to "camera")

Saegusa also discloses this limitation (see references within Saegusa to "camera").

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4. Claims 33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Olympus" and Saegusa as applied to claims 30 and 34 above, and further in view of "IEEE 1394: A Ubiquitous Bus" ("IEEE 1394").

Regarding claim 33, "Olympus" and Saegusa disclose the method of claim 30.

"Olympus" and Saegusa do not expressly disclose wherein the serial bus conforms to IEEE 1394 standards, however, "IEEE 1394" does disclose such a communication bus in the context of image transferring (page 1, specifically "Its scalable architecture and flexible peer-to-peer topology make 1394 ideal for connecting devices from computers and hard drives, to digital audio and video hardware"; page 2, specifically "Broad markets for 1394 digital data transport include:...audio, image, and video products for multimedia, printer and scanner products for imaging...")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since "IEEE 1394" discloses that using the IEEE 1394 bus allows for a universal I/O connection and a scalable architecture between devices such as printers and imaging devices (see page 1). In view of these specific advantages and that the references are directed transferring

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image data between nodes over a communication bus, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Claim 37 is also rejected since this claim recites substantially the same limitations as recited in claim 33.

5. Claims 33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell and Saegusa as applied to claims 30 and 34 above, and further in view of "IEEE 1394: A Ubiquitous Bus" ("IEEE 1394").

Regarding claim 33, Bell and Saegusa disclose the method of claim 30.

Bell and Saegusa do not expressly disclose wherein the serial bus conforms to IEEE 1394 standards, however, "IEEE 1394" does disclose such a communication bus in the context of image transferring (page 1, specifically "Its scalable architecture and flexible peer-to-peer topology make 1394 ideal for connecting devices from computers and hard drives, to digital audio and video hardware"; page 2, specifically "Broad markets for 1394 digital data transport include:...audio, image, and

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video products for multimedia, printer and scanner products for imaging...")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since "IEEE 1394" discloses that using the IEEE 1394 bus allows for a universal I/O connection and a scalable architecture between devices such as printers and imaging devices (see page 1). In view of these specific advantages and that the references are directed transferring image data between nodes over a communication bus, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Claim 37 is also rejected since this claim recites substantially the same limitations as recited in claim 33.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



George C. Neurauter, Jr.
Patent Examiner